

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	10/688,261
Applicant	:	Norbert Hahn
Confirmation No.	:	4594
Filed	:	October 17, 2003
TC/A.U.	:	3721
Examiner	:	Weeks, Gloria R.
Customer No.	:	28268
Docket No.	:	P-US-PR-1088
Title	:	TOOL HOLDER FOR IMPACTING MACHINE

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Commissioner for Patents  
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**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE REVIEW**

Sir:

In response to the Office Action mailed on June 10, 2010, please reconsider the above-identified application in view of the following Remarks:

**Remarks** begin on page 2 of this paper.

### **REMARKS**

Claims 1, 3-7, 9, 10, 12-25 and 33 are pending in this application. Claims 1, 3-7, 9, 10, 12-25 and 33 stand rejected. Claims 2, 8, 11, and 26-32 have been cancelled.

Claims 1, 3-7, 9, 10, 12-19 and 33 are rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent No. 5,820,136 to Han et al. (“*Han*”). Claims 1, 20-25, and 33 are rejected under 35 U.S.C. §102(b), as being unpatentable over U.S. Patent No. 5,921,563 to Huggins et al. (“*Huggins*”). These rejections are respectfully traversed.

Neither *Han* nor *Huggins* teaches each feature of the claimed invention. Each reference respectively teaches a locking element 30, 32, having an engaging member 70, 56 that engages a collet 16, 26 which collet is not part of the tool as claimed in claim 1. In other words, both *Han* and *Huggins* fail to teach that “the engaging portion is engagable with the retaining collar of the tool”. Furthermore, claim 1 requires that the tool is able to be removed from the main body. Therefore, even if for argument sake, *Han*’s and *Huggins*’ irremovable collets are considered to be a portion of the tool, then the tool cannot be removed from the chuck as required by claim 1. Finally, a reasonable interpretation of the claims in light of the specification could never support an interpretation that the slight movement between the collets and their respective main bodies 12, 18 constitutes being “removed from the main body” as required by claim 1.

Applicant suspects that the reasoning behind the above rejections is that the tool is not “positively recited”, and as a result, all recitation regarding the tool can be ignored for claim interpretation purposes. Applicant further suspects that the Examiner’s position is that functional language – especially regarding the tool – can be disregarded or given no weight. Applicant disagrees. Every word of the claim affects the scope of the claim. Applicant is reminded of the following from the MPEP:

#### **C. FUNCTIONAL LANGUAGE - MPEP 2173.05(g):**

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. See, for example, *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) wherein the Court held that in a claim directed to a kit of component parts capable of being assembled, limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

#### **2111.02 Effect of Preamble [R-3]**

The determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim.

*Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed. Cir. 2002). See *id.* at 808-10, 62 USPQ2d at 1784-86 for a discussion of guideposts that have emerged from various decisions exploring the preamble's effect on claim scope, as well as a hypothetical example illustrating these principles.

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). See also *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)

In other words, regardless of the use of function language, the Examiner has the burden of finding an anticipating reference that can be reasonably said to be capable of performing each of the claimed functions. Furthermore, it is improper for the Examiner to ignore language in the preamble without which positively claimed recitations would have no meaning or little meaning.

In this case, claim 1 positively recites – all-be-it functionally – that “the engaging portion is engagable with the retaining collar of the tool”. There is no discussion in the Office Action regarding how the engaging portion is capable of engaging the retaining collar of the tool. Applicant is therefore left to conclude that this language has been ignored or given now weight. In addition, the tool is defined in the preamble as “having a shank portion on which is formed a retaining collar”. Therefore, even if the Examiner considers collet 16, 26 to be equivalent to the claimed retaining collar, the collar must be formed on a shank portion which is not taught in either *Han* or *Huggins*.

Said another way, the Examiner argues that there is a reasonable interpretation of claim 1 in which claim 1 reads on chucks of the type disclosed in *Han* and *Huggins*. Applicant, however, is arguing that if the functional language of claim 1 is properly considered and if the definitions set out in the preamble are properly considered, claim 1 will read neither on *Han* nor on *Huggins*. While the tool is not being claimed, the only way to determine whether *Han* or *Huggins* is reasonably capable of performing the claimed function using the unclaimed tool is to seek guidance from the preamble which recites the tool structure.

For at least the reasons stated above, claims 1, 3-7, 9, 10, 12-25 and 33 are therefore believed to include unique allowable subject matter. The Examiner is therefore requested to withdraw the rejection of claims 1, 3-7, 9, 10, 12-25 and 33. However, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney to discuss any unresolved issues and to expedite the disposition of the application.

No fees are believed to be due. However, the Commissioner is hereby authorized to charge payment of any additional fees required for the above-identified application or credit any overpayment to Deposit Account No. 02-2548.

Dated: September 8, 2010

Respectfully submitted by:

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